

REMARKS

Claim 1 has been amended to recite "remaining" rather than "reminder." No new matter has been added. Thus, claims 1-4 remain presented for examination. Reconsideration and withdrawal of the present rejections in view of the comments presented herein are respectfully requested.

Obviousness-type double patenting rejection

Claims 1-4 were provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1 and 4 of commonly owned copending Application No. 10/560,155 in view of Pfeifer (U.S. 3,207,725). Applicants respectfully request that this rejection be held in abeyance until the indication of allowable subject matter in the present application or in Application No. 10/560,155.

Rejection under 35 U.S.C. 103(a)

Claims 1-4 were rejected under 35 U.S.C. 103(a) as being obvious over Sato et al. (U.S. 5,985,525) in view of Pfeifer (U.S. 3,207,725). The Examiner alleges that it would have been obvious to include an alkali metal salt of an alkyl diphenyl ether sulfonic acid for reasonable expectation of obtaining an additional benefit of an analogous anionic surfactant in the art and/or to use an alkali metal salt(s) in place of an ammonium salt(s) in alkyl diphenyl ether sulfonic acid(s). However, as explained below, this combination of references would not render the claimed invention obvious.

A *prima facie* case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). The claimed developer compositions for resists comprise an organic quaternary ammonium base and an anionic surfactant comprising an alkali metal salt of an alkyl diphenyl ether sulfonic acid. Sato et al. disclose a developer composition comprising an organic quaternary ammonium base and an ammonium salt of alkyl diphenyl ether sulfonic acid. Sato et al. specifically state that the presence of a metallic element has adverse effects on the performance of the semiconductor devices because the metallic "contaminant" can come away from the developer solution (See Sato et al, at Col. 1, lines 24-29). Thus, Sato et al. clearly teaches away from the use of metallic components, such as the claimed alkali metal salt of an

alkyl diphenyl ether sulfonic acid, because metallic components are expressly taught to be detrimental to performance of the semiconductor. Since Sato et al. teach away from the use of metallic elements, one of ordinary skill in the art would not be motivated to substitute an alkali metal salt of alkyl diphenyl ether sulfonic acid as disclosed by Pfeifer for an ammonium salt in the composition of Sato et al. because such metal-containing compositions are taught to be undesirable.

According to M.P.E.P. 2143.01(V), a proposed modification cannot render the prior art unsatisfactory for its intended purpose. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In the present case, the use of a metal-containing salt in the method of Sato would negatively impact the performance of the semiconductors of Sato so that they would no longer be suitable for their intended purpose. Thus, the claims cannot be obvious in view of this combination of references.

Furthermore, M.P.E.P. 2141.01(a) states that to rely on a reference under 35 U.S.C. 103(a), it must be analogous prior art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). The present claims are directed to developer compositions for resists which is in a completely different technical field than the dyeable polyolefin (e.g., polypropylene) compositions disclosed by Pfeifer. Thus, a person of ordinary skill in the art looking to modify a composition used in the semiconductor art as disclosed by Sato et al. would not rely on a patent directed to polyolefin compositions which is completely unrelated to semiconductors.

In view of the comments presented above, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. 103(a).

Tanaka et al. (U.S. 5,543,268) and Tanaka et al. (U.S. 6,329,126)

The Examiner alleged that Tanaka et al. (U.S. 5,543,268) and Tanaka et al. (U.S. 6,329,126) have about the same teachings and suggestions as those in Sato et al. and are therefore cumulative. Applicants note that, like Sato et al., both of these references also explicitly teach

away from the use of metallic components (See Tanaka '268 at column 1, lines 48-62; and Tanaka '126 at column 1, lines 50-64). Thus, for the reasons discussed above in regard to Sato et al., neither of the Tanaka et al. patents in combination with Pfeifer would render the claimed invention obvious.

CONCLUSION

Applicants submit that all claims are in condition for allowance. Should there be any questions concerning this application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Respectfully submitted,

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